

## **REMARKS**

### **Claim Rejections**

Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-8 and 11-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lobo et al. (U.S. 5,835,616) in view of Giacchetti (U.S. 2003/0065589). Claims 9-10 and 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lobo et al. in view of Tian et al. (U.S. 2003/0133599).

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

### **Claim Amendments**

By this Amendment, Applicant has amended independent claim 1, dependent claims 2-10 and 12-18, and has added new independent claim 19 to this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

On pages 7 and 8 of the outstanding Office Action, the Examiner listed the following three limitations supported in the Specification and discussed in the Applicant's Response, filed May 25, 2005, but not included in the claimed subject matter:

- 1) "[each of the plurality of face adjusting templates] are selectable either manually or automatically for reuse";
- 2) "the original facial image obtained by the image-reading unit is selectively adjusted [using] one of the template selection unit and the manual adjusting unit"; and
- 3) the templates adjust a real human facial image obtained by the image reading unit".

Amended independent claim 1 and new independent claim 19 include each of the above listed limitations.

Applicant believes, that neither Lobo et al., Giacchetti, nor Tian et al. teach: the real human facial image obtained by the image-reading unit is selectively adjusted using a unit selected from a group consisting of the template selection unit and the manual adjusting unit; each of the plurality of face adjusting templates are selectable for reuse utilizing one of the template selection unit for an automatic selection and the manual selection unit for a manual selection; or the plurality of face adjusting templates adjust the real human facial image obtained by the image reading unit.

Applicant believes that these assertions are also consistent with the Examiners *Response to Arguments* of the outstanding Office Action.

Even if the teachings of Lobo et al., Giacchetti, and Tian et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: the real human facial image obtained by the image-reading unit is selectively adjusted using a unit selected from a group consisting of the template selection unit and the manual adjusting unit; each of the plurality of face adjusting templates are selectable for reuse utilizing one of the template selection unit for an automatic selection and the manual selection unit for a manual selection; nor does the combination suggest the plurality of face adjusting templates adjust the real human facial image obtained by the image reading unit.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the

light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Lobo et al., Giacchetti, or Tian et al. that their respective teachings may be combined as

suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Lobo et al., Giacchetti, nor Tian et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

**Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal.

It is not believed that the foregoing amendments to the claims and the addition of new independent claim 19 require any further searching and/or consideration on the part of the Examiner, since such amendments merely include incorporating the subject matter evaluated by the Examiner in the outstanding Office Action. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of the claims.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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